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|--|-------------|----------------------|---------------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/993,767 | 11/27/2001 | Ming-Sum Fang | 12283 | 7588 |
| 25763 7590 03/30/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498 | | | EXAMINER HEWITT II, CALVIN L | |
| | | | ART UNIT 3621 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | |
| 3 MONTHS | | | 03/30/2007 | |
| | | | DELIVERY MODE | |
| | | | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/993,767

Applicant(s)

FANG ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,10-17,20-23,25-27,29,30,32,33,35-39 and 42-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 8, 10, 11-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1, 3-5, 7, 8, 10, 11, 12, 14-17, 20, 23, 25-27, 29, 30, 32, 33, 35-39, and 42-63 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art does not teach monitoring a card terminal to detect at least one activity performed at the card terminal, detecting the activity performed at the terminal and based on the detection of said activity, electronically transmitting information related to a request. The Examiner respectfully disagrees. Desai et al. teach a configuration server authenticating a card terminal that is to be configured (column 13, lines 31-42). More specifically, Desai et al. teach the server monitoring the card terminal (column 13, lines 30-34) and detecting activities performed at the terminal such as the entering of an identifying token (column 13, lines 48-62; column 14, lines 5-8), generating of a digital signature (column 13, lines 62-66), and based on the detection transmitting information related to the download request (column 14, lines 8-26).

Non-functional data, a software module in an apparatus claim and how an apparatus is "configured" or steps it is intended to perform do not distinguish a claim(s) from the teachings of the prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8, 10, 11, 13-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 8 recites the limitation "the information configuration data" in line

5. There is insufficient antecedent basis for this limitation in the claim.

Claims 10, 11 and 13-15 are also rejected as each depends from claim 8.

b. The term "a time proximate to a time at which the at least one activity is performed" in claim 17 is a relative term which renders the claim indefinite. The term "a time proximate to a time at which the at least one activity is performed" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-5, 7, 8, 10, 11, 14-17, 20, 23, 25-27, 29, 30, 32, 33, 35-39, and 42-63 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Desai et al., U.S. Patent No. 6,877,093.

As per claims 1, 3-5, 7, 8, 10, 11, 14-17, 20, 23, 25-27, 29, 30, 32, 33, 35-39, and 42-63, Desai et al. teach a method and system for downloading an application to a card terminal (figure 4) comprising:

- receiving a request from a remote network connection a request to download an application to a card terminal using a processing arrangement (figure 6; column/line 10/3-11/32; column 13, lines 5-10)

- using the processing arrangement (figure 6; column/line 10/3-11/32) monitoring a card terminal (column 13, lines 30-34) to detect at least one activity (e.g. process a transaction or close a batch) performed at the card terminal and detecting the monitored activity downloading, by generating and transmitting a data stream over TCP/IP, the application to the card terminal wherein the terminal is reconfigured based on the application (figure 4; column 3, lines 4-11; column/line 6/66-7/24; column 10, lines 15-33; column/line 12/56-13/30; column 13, lines 30-34 and 38-66; column 14, lines 5-8)
- downloading an application to provide an indication of information to be printed on a receipt, audio information to be generated at card terminal or visual information to be displayed (column 3, lines 4-11; column 7, lines 24-37; column 8, lines 23-46; column 13, lines 6-29)
- transmitting a message to the card terminal relating to the triggering of the downloading of configuration data (column 9, lines 41-46; column/line 12/56-13/30)
- a processing arrangement comprising storage containing data related to card terminal configuration (figure 6; column/line 10/3-11/32; column/line 12/56-13/30)

- monitoring the terminal based on the request to re-configure the terminal (column 13, lines 30-34)

Desai et al. teach a user at a card terminal communicating with a web server over the Internet (e.g. dial-up, high-speed, etc.) (column/line 5/60-6/8; column 9, lines 42-46; column 10, lines 2-15) wherein the user and the server interact using a website (figure 8; column 12, lines 56-65) or GUI (column 9, lines 41-46).

Claim Rejections - 35 USC § 103

7 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al., U.S. Patent No. 6,877,093.

As per claims 13 and 22, the type of information transmitted does not distinguish the claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

As per claim 21, claim 16 and 21, merely recite generating information "for display". Hence, as the configuration server of Desai et al. can format information

for display (column/line 12/56-13/20) it continues to at least obviate Applicant's claimed method (MPEP 2114; *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

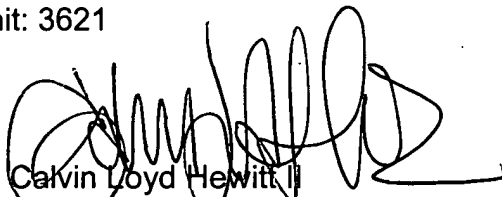
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Lloyd Hewitt II
Primary Examiner

March 14, 2007